SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, A. D. 1905.

NO. 18 ORIGINAL.

EX PARTE.

IN THE MATTER OF

AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY,
Petitioner

BRIEF OF COUNSEL FOR THE CUTLER-HAMMER MFG. CO. IN OPPOSITION TO PETITION FOR WRIT OF MANDAMUS.

The Automatic Switch Company of Baltimore City, has been granted leave to file a petition for writ of mandamus and a rule has been entered upon the United States Circuit Court of Appeals for the Second Circuit, to show cause why a writ of mandamus should not issue, requiring that court to entertain an appeal of the Automatic Switch Company of Baltimore City prosecuted from a decree entered under date of May 26th, 1905, in a suit entitled *The Automatic Switch Co. of Baltimore City* v. *The Cutler-Hammer Mfg. Co.*

The return of the Circuit Court of Appeals has been made and filed before this court and this brief is presented in support of said return and in opposition to the petition for the writ of mandamus.

It is submitted in behalf of the return, that the writ of mandamus should not issue, and the rule should be discharged:

First, because under the circumstances of this case the issuance of the writ of mandamus is not the proper practice; and

Second, because on the merits the Circuit Court of Appeals did not err in dismissing complainant's appeal.

Statement of Facts.

The return of the judges of the Circuit Court of Appeals in response to the rule to show cause, sets forth fully the pertinent facts bearing upon the question of appeal involved herein.

The decision of the Hon. William K. Townsend, Circuit Judge, found claims 4 and 5 of the patent in suit to be valid and infringed and granted an injunction and an accounting with respect thereto and found claims 6, 7 and 8 not infringed.

April 20, 1905, the first decree was entered and filed; this decree found all of the claims in suit, 4, 5, 6, 7 and 8 valid, and found claims 4 and 5 infringed, and granted an injunction and an accounting with respect thereto. This first decree did not find the non-infringement of claims 6, 7 and 8, nor did it refuse an injunction or dismiss the bill of complaint with respect to claims 6, 7 and 8. The first decree found validity of claims 6, 7 and 8, but was silent as to the infringement thereof.

May 12th, 1905, defendant's appeal from the first decree dated April 20th, 1905 was allowed.

May 13th, 1905, citation was issued and served upon complainant.

May 26th 1905, the second or so-called "final" decree was entered and filed at the instance of complainant; this decree found non-infringement of claims 6, 7 and 8 and dismissed the bill of complaint with respect thereto.

June 7th, 1905, appeal by complainant was allowed from this second decree *after* defendant's appeal from the first decree had been perfected.

June 9th, 1905, the transcript of record containing documents specified by both parties in accordance with the rules was certified to by the clerk of the Circuit Court.

June 9th, 1905, the transcript of record was filed with the clerk of the Circuit Court of Appeals.

In view of the facts as above outlined and as set forth in the return certified to by the judges of the Circuit Court of Appeals, it will appear that the petition for the writ of mandamus and the brief in

support thereof are based on two misconceptions or misstatements as to the record and facts in this case.

(1) The petition and brief assume that the first interlocutory decree entered April 20, 1905, found claims 6, 7 and 8 *not infringed* (pages 3 and 10). As a matter of fact, however, the interlocutory decree of April 20, 1905, found claims 4, 5, 6, 7 and 8 valid and claims 4 and 5 infringed, but did not make any finding as to claims 6, 7 and 8 *with respect to infringement*. Nor did this first decree refuse an injunction or dismiss the bill of complaint as to claims 6, 7 and 8. This misconception or misstatement has an important bearing upon the petitioner's position, as will hereafter appear, since the authority upon which the petitioner principally relies is a case in which a *single* decree granted an injunction as to certain claims and refused an injunction as to other claims. In the present case there was one decree granting an injunction as to certain claims, from which an appeal was prosecuted, and *after* the appeal had been perfected, a *second* decree was entreed refusing an injunction as to other claims, from which second decree complainant prematurely undertook to prosecute an appeal.

(2) The petition and brief state that the *entire record* had been taken to the Court of Appeals by defendant *before* the appeal by complainant (pages 3, 4, 16, 17 and 19). As a matter of fact, at the date of complainant's appeal no transcript had been made up in the Circuit Court, nor had any transcript been filed in the Court of Appeals. After complainant's appeal, pursuant to the practice of the court requiring each party to pay one-half the expenses of the appeal, when both appeal, stipulation was made providing that each party should furnish the necessary copies of its printed record, the additional expenses to be paid half and half in accordance with the rules. A joint record was thereafter made up. At the date, therefore, of complainant's appeal, there was *not* a *complete* record taken up by defendant upon which a cross appeal could be based, or, in fact, any record.

I.

As to The Practice.

It is submitted that the writ of mandamus should not issue in the present case, because in view of the authorities we shall review the issuance of the writ is not warranted by the facts and circumstances of this case:

(1) Because the petitioner has another adequate remedy.

(2) Because the Supreme Court of the United States has neither original nor appellate jurisdiction of this cause; and

(3) Because the order sought to be reviewed by the writ of mandamus is an interlocutory order entered in the progress of the litigation and is not of that final and conclusive character which puts an end to the particular litigation and which alone warrants the issuance of the writ.

We shall consider these three grounds in the order above enumerated.

(1)

The writ of mandamus will not issue to correct the error of a subordinate tribunal unless there is no other adequate remedy.

Ex parte Newman, 14 Wall., 169.

In re Key, 189 U. S., 84.

In re Tampa Suburban R. R. Co., 168 U. S., 583.

In re Morrison, 147 U. S., 14, 26.

In re Pennsylvania Co., 137 U. S., 451, 453.

In re Key, supra, this court, by Justice Fuller, referring to the writ of mandamus, said:

> "It is not granted in doubtful cases, or where there is another adequate remedy, and whether it shall go or not usually rests in the sound discretion of the court."

In *Ex parte Newman, supra*, this court, by Justice Clifford, said:

> "Superior tribunals may, by mandamus, command an in-

ferior court to perform a legal duty where there is no other remedy."

In re Morrison, supra, this court, by Justice Blatchford, said (p. 26):

"In addition to this, a mandamus is never granted where the party asking it has another remedy."

In the present case, the complainant has an ample remedy. Complainant's appeal was based on the theory that the decree of May 26th, 1905, from which the so-called "cross appeal" was prosecuted, was a *final decree.* As a matter of fact, it was not a final decree because it merely dismissed the bill of complaint as to claims 6, 7 and 8, which were held not infringed, and thus did not dispose finally of the litigation before the court. At the date of the entry of this decree, the first decree granting an injunction as to claims 4 and 5 was pending on appeal before the Circuit Court of Appeals and the accounting as to claims 4 and 5 was pending before the Circuit Court.

Complainant's appeal was dismissed because it was *prematurely* taken. After the accounting and the entry of a *final* decree, complainant will have the right to prosecute an appeal to the Circuit Court of Appeals and can then have reviewed the question of infringement of claims 6, 7 and 8, which is the question sought to be prematurely reviewed by the appeal which has been dismissed.

It is thus apparent that the petitioner has an adequate, full and complete remedy by prosecuting an appeal after the entry of the final decree, and in view of this fact, it is submitted that the writ of mandamus should not issue.

(2)

The Supreme Court of the United States has neither original nor appellate jurisdiction of this cause and it cannot, therefore, grant the writ of mandamus.

In re Massachusetts, 197 U. S., 482.

In re Glaser, 198 U. S., 171.

In re Green, 141, U. S., 325.

In re Massachusetts, *supra*, this court, by Mr. Chief Justice Fuller, said (page 488):

> "And it has been repeatedly held as to the Circuit Courts, that they have no power under Sec. 716 to issue writs of prohibition and mandamus, except when necessary in the exercise of their existing jurisdiction. *Bath County* v. *Almy*, 13 Wall., 244. 248; *McClung* v. *Silliman*, 6 Wheat. 598, 601.
>
> "This is equally true of this court, that is to say, that in cases over which we possess neither original nor appellate jurisdiction we cannot grant prohibition or mandamus or certiorari as ancillary thereto.
>
> "*Rule discharged; petition denied.*"

In re Glaser, *supra*, this court, by Mr. Chief Justice Fuller, said (page 173):

> "In cases over which we possess neither original nor appellate jurisdiction, we cannot grant mandamus. Rev. Stat. Sec. 716; *In re Commonwealth of Massachusetts, Petitioner*, 197 U. S. 482.
>
> "Of course there is no pretense of original jurisdiction here, and since the passage of the act of March 3, 1891, 26 Stat. 826, c. 517, we have no jurisdiction to review the judgments or decrees of the District and Circuit Courts directly by appeal or writ of error in cases such as this case if pending in the Circuit Court.
>
> "*Rule discharged. Petition denied.*"

Since the passage of the Judiciary Act of March 30, 1891, referred to above, suits in equity for the infringement of letters patent, such as the present suit, are not reviewable by appeal or writ of error by the Supreme Court of the United States. Accordingly, the present case is in the same category as *in re Glaser supra*, and the writ of *mandamus* should not, it is submitted, be issued in aid of a cause of which this court possesses neither original or appellate jurisdiction.

(3)

The writ of mandamus cannot be used to correct judicial errors committed by an inferior court in the progress of a cause of which it accepts jurisdiction.

American Co. v. *Jacksonville Ry.*, 148 U. S., 372.
Ex parte Perry, 102 U. S., 183, 186.
Ex parte Schwab, 98 U. S., 240, 241.
Ex parte Whitney, 13 Peters, 404.

The writ of mandamus, when issued to require an appellate tribunal to entertain or reinstate an appeal dismissed for lack of jurisdiction, is issued only where the order, decree or judgment appealed from definitely and conclusively puts an end to the particular subject-matter in litigation and where the dismissal of the appeal puts it out of the power of the petitioner to take further action in the litigation.

See cases cited and relied upon by the petitioner and hereafter reviewed.

In the present case, the Circuit Court entertained jurisdiction and adjudicated the cause; two decrees were entered, one finding claims 4 and 5 infringed and granting an injunction and an accounting with respect thereto. Defendant appealed from this decree and the Circuit Court of Appeals has entertained this appeal and the appeal is now pending, and awaiting final hearing. After defendant's appeal, a second decree was entered dismissing the bill of complainant as to claims 6, 7 and 8, found not infringed. Complainant prosecuted a separate and independent appeal from this decree. An *interlocutory order* has been entered by the Circuit Court of Appeals dismissing this second appeal for lack of jurisdiction. The appeal was taken by complainant on the mistaken assumption that it was a final decree. The appeal was dismissed because premature. Complainant will have an opportunity to present the same subject-matter to the Court of Appeals upon appeal from the final decree when entered. The interlocutory order dismissing the appeal is, therefore, merely an order entered during

the progress of a cause of which the Court of Appeals has entertained jurisdiction.

The order dismissing complainant's appeal does not therefore put *the cause* out of court, but merely removes from the present consideration of the Court of Appeals the question of the infringement of claims 6 and 7, which was involved in complainant's appeal.

In *Ex parte Perry, supra*, this court, by Mr. Chief Justice Waite, said (page 186):

> "We cannot by *mandamus* correct the judicial errors committed by an inferior court *in the progress of a cause*. *Ex parte Schwab*, 98 U. S. 240. We can in this way, in a proper case, compel an inferior court to act, but cannot control its decisions while acting. In the present case it appears that the Circuit Court has acted on the motion of the petitioner, and denied him what he asked. The object of this proceeding is to obtain from us an order requiring that court to reverse its former decision and grant the relief it has once refused. That is the office of a writ of error or an appeal, and not of a writ of *mandamus*. *Ex parte Flippin*, 94 U. S., 248; *Ex parte Loring*, id. 418. Neither is the case changed because the appropriate remedy may involve an inconvenient delay. In *Ex parte Whitney* (13 Pet. 404), it was held that a writ of *mandamus* ought not to be used to correct orders made by a judge in the exercise of his authority, even though such orders 'may seem to bear harshly or oppressively upon the party' complainant.
>
> "*Mandamus refused.*" (Italics ours.)

The appropriate remedy in the present case is an appeal after the entry of the final decree. Complainant's objection to this remedy is that it will cause an inconvenient delay, but in view of the above decision, such inconvenient delay cannot authorize the issuance of the writ. The Circuit Court of Appeals has entertained the cause on appeal, and has merely entered an interlocutory order dismissing *part* of the subject-matter from the present appeal because it is premature and does not properly arise for adjudication until after the entry of the final decree. Even though the delay until the final decree may seem to bear harshly or oppressively

upon the petitioner, this fact cannot warrant the issuance of the writ.

In *Ex parte Schwab, supra*, this court, by Mr. Chief Justice Waite, said:

> "When the application was made for the allowance of the injunction, it became the duty of the court to determine whether the case was one in which that power could be exercised. The question arose in the *regular progress of the cause*, and, if decided wrong, an error was committed, which, like other errors, may be corrected on appeal *after final decree below*.
>
> "The case is entirely different from what it would have been if the *only* object of the suit had been to enjoin Schwab from proceeding in the State court. There the question would have been as to the jurisdiction of the Circuit Court *over the cause*. But here is clearly jurisdiction *of the cause*. The assignee in bankruptcy had the undoubted right to sue Schwab in the Circuit Court to settle the title to the goods or the fund arising from their sale. The injunction was *a mere incident* to the *principal* relief he asked. *Even if not granted, the suit could go on.*
>
> "Being satisfied, by the petitioner's own showing, that the error, if any, in the court below cannot be corrected by mandamus, we deny the motion for an order to show cause.
>
> "*Motion denied.*" (Italics ours.)

Likewise, in the present case, the question as to the allowance of the appeal relating to the question of infringement of claims 6 and 7, arose in the regular progress of the cause, and if the Court of Appeals was in error in dismissing this partial appeal, the error can be corrected after the final decree below.

In the present case there is no question as to the jurisdiction of the Circuit Court of Appeals *over the cause* and the question of the second appeal was a mere incident to the principal relief asked. "Even if not granted, the suit could go on."

In *American Co.* v. *Jacksonville Ry. Co., supra*, this court, by Mr. Justice Gray, said (p. 379):

> "Least of all can a writ of mandamus be granted to review a ruling or *interlocutory order* made in the progress of a cause; for, as observed by Chief Justice Marshall, to do this 'would

> be a plain evasion of the provision of the act of Congress that final judgments only should be brought before this court for re-examination;' would 'introduce the supervising power of this court into a cause while depending in an inferior court, and prematurely to decide it;' would allow an appeal or writ of error upon the same question to be 'repeated, to the great oppression of the parties;' and 'would subvert our whole system of jurisprudence.' *Bank of Columbia* v. *Sweeny*, 1 Pet. 567, 569; *Life & Fire Ins. Co.* v. *Adams*, 9 Pet., 573, 602." (Italics ours.)

In *Ex parte Whitney, supra*, this court, by Mr. Justice Story (p. 408), said:

> "The district Judge *is proceeding in the cause*, however irregular that proceeding may be deemed; and the appropriate redress, if any, is to be obtained by *an appeal after the final decree* shall be had in the cause. A writ of mandamus is not the appropriate remedy for any orders which may be made in a cause by a judge in the exercise of his authority; although they may seem to bear harshly or oppressively upon the party. The remedy in such cases must be sought in some other form." (Italics ours.)

The Petitioner's Authorities. In each of the cases cited in the petitioner's brief in support of the issuance of the writ of mandamus, the order, judgment or decree appealed from definitely and without recourse put an end to the particular subject-matter in litigation, or to the litigation against the particular defendant, so that further action of the petitioner was effectually blocked unless by the issuance of the writ of mandamus.

In the present cause, the dismissal of complainant's cross appeal does not put an end to the litigation or block the petitioner's further progress in the litigation. On the contrary, the litigation proceeds to adjudication by the Court of Appeals as to the propriety of granting the injunction as to claims 4 and 5, and the accounting proceeds before the Circuit Court as to claims 4 and 5, and the cause proceeds to the eventual entry of a final decree and to the review of all questions (including the one sought to be raised by the second appeal) upon appeal from the final decree.

The interlocutory order dismissing complainant's cross-appeal is

therefore not such an order as effectually puts an end to the litigation and calls for the issuance of the writ of mandamus.

We shall now review briefly the several authorities relied upon by the petitioner and show that in each case the erroneous order, judgment or decree which was corrected by the issuance of the writ of mandamus, would, had it not been corrected, have completely blocked any further action by the petitioner and would have put an end to the particular litigation concerned.

Insurance Co. vs. Comstock, 16 Wall., 258. A final judgment was entered in this case after trial by jury and verdict. A writ of error was prosecuted which was dismissed for want of jurisdiction. The writ of mandamus was issued to correct the error. This was a case in which the decree was final, so that the dismissal of the writ of error effectually put an end to the litigation, and the petitioner had no other remedy had the writ not issued. This case is clearly not an authority in support of the present petition, which undertakes (1) to review an *interlocutory order* dismissing an appeal as to *a part* of the subject-matter in litigation; (2) in a cause in which the Supreme Court does not have appellate jurisdiction; and (3) in which complainant has an adequate remedy by the prosecution of an appeal after the entry of the final decree.

Vigo's case, 21 Wall., 648. This was an action in the court of claims against the United States. After the entry of final judgment, the United States asked the allowance of an appeal to the Supreme Court, which was refused. Application was made for writ of mandamus to compel the allowance of the appeal, which was granted. This was a case in which the refusal of the appeal put an end to the litigation, and put it beyond the power of the petitioner to take any further action in the establishment of its rights.

Railroad Co. vs. Wiswall, 23 Wall., 507. The petitioner sued in one of the state courts of Illinois. Defendant secured an order from the Circuit Court of the United States for that district for the removal of the cause to that court. The Circuit Court, upon looking further into the matter, was satisfied that it had no jurisdiction and remanded the case to the state court, thus putting

it effectually out of the power of the petitioner to proceed further in the federal courts without the aid of the writ of mandamus. This was not a final judgment or decree after a full hearing upon the merits, such that, an appeal or writ of error could be prosecuted, although it was a final judgment definitely barring the petitioner from further proceedings in the federal courts. Accordingly, the writ of mandamus issued.

Ex parte Jordan, 94 U. S., 248. In this case certain interlocutory orders were entered during the progress of the cause and after the entry of a final decree the allowance of an appeal was requested for the purpose of reviewing the correctness of the interlocutory orders as well as some of the findings of the final decree, but was refused. The writ of mandamus was requested and issued. Although some of the errors complained of related to the interlocutory orders, the appeal from the final decree was properly taken and under such an appeal the errors in the entry of the interlocutory orders could be reviewed. The court further held that the petitioner was not estopped from questioning the provisions of the final decree which had been appealed from. This, therefore, was a case in which the refusal of the appeal ended the litigation and put it out of the power of the petitioner to further assert his rights.

Ex parte Railroad Co., 95 U. S., 221. In this case a bill was filed against a number of defendants. A cross-bill was filed by the Alabama Company, one of the defendants. This cross-bill was disposed of by special interlocutory decree, and at the termination of all the litigation a final decree was entered. The Alabama Co. thereupon prayed an appeal, which was refused. A writ of mandamus was thereupon prayed. This court held, in effect, as we understand the decision, that although the special decree disposing of the cross-bill was interlocutory, this decree could be reviewed upon an appeal from the final decree, and that, accordingly, the appeal of the Alabama Co. should have been allowed.

The writ of mandamus was accordingly issued. This was a case where the refusal of the appeal put the Alabama Co. out of court and ended the controversy and the petitioner had no recourse except

through the writ of mandamus. The allowance of the appeal was requested after the entry of the final decree settling all matters in dispute in the litigation.

Ex parte Parker, 120 U. S., 737. In this case a final decree was entered against the two defendants severally and an appeal was taken by the defendant Parker. The appeal was from the District Court of Washington Territory to the Supreme Court of Washington Territory; and this appeal having been dismissid, the writ of mandamus was sought to require its reinstatement. The dismissal was on the ground that one of the co-defendants could not individually appeal. The dismissal of the appeal effectually put it out of the power of the petitioner to continue the litigation or protect his rights. The writ of mandamus was accordingly issued. The decree appealed from was final and the dismissal of the appeal effectually put an end to the litigation, so far as the petitioner was concerned.

Hollard Parker, 131 U. S., 221. In this case a final judgment was entered after trial by jury and verdict. An appeal from the judgment thus entered by the District Court of the Territory of Washington was taken to the Supreme Court of the Territory, and this appeal was dismissed on the ground that no assignment of errors had been properly filed and served on the opposite party. The writ of mandamus was sought to compel the reinstatement of the appeal and was granted. This was a case in which the dismissal of the appeal finally ended the litigation and put it out of the power of the petitioner to proceed further without the aid of the writ of mandamus.

Ex parte Hohorst, 150 U. S., 653. This was a suit for infringement against a number of parties, one being a corporation. The appeal was dismissed against the corporation on the ground that the service was defective. From this order the complainant took an appeal to the Supreme Court of the United States and this appeal was dismissed for want of jurisdiction. Writ of mandamus was then sought to compel the Circuit Court to take jurisdiction as against the company on the ground that the service was not

defective. The writ of mandamus was granted. In this case the order dismissing as to the corporation, while not being a final decree putting an end to all of the litigation from which an appeal could be taken, was an order which finally ended the litigation and put a stop to it, so far as the corporation defendant was concerned. The petitioner was without further recourse against the corporation defendant in the litigation unless by writ of mandamus.

Matter of Christensen Co., 194 U. S., 458. In this case a preliminary injunction was granted against the infringement of a patent. Subsequent to the grant of the injunction and prior to the final decree, defendant was adjudged guilty of contempt for violation of the injunction. A writ of error was sued out to review the order adjudging contempt. This writ of error was dismissed by the Court of Appeals for want of jurisdiction and the writ of mandamus was sought to require the reinstatement of the writ of error. The question to be decided was whether the contempt order was an interlocutory or a final adjudication. If the fine was compensatory, it was undoubtedly ancillary to the infringement suit. If the fine was punitive, the contempt order had an independent standing, and was of such a final character as to warrant an appeal independently of the appeal in the infringement suit. This court held, as we read the decision, that in view of the fact that one-half of the fine went to the United States, it was punitive. Accordingly, the contempt order was not an interlocutory order in the infringement suit, but was of such an independent character that an independent appeal was proper. Accordingly, the writ of mandamus was issued to compel the reinstatement of the appeal.

This decision is authority for the proposition that the writ of mandamus is *not* proper to require the reinstatement of a dismissed appeal from an *interlocutory* order and in line with *American Co.* v. *Jacksonville Co., supra,* It is clear from the reasoning of the court that had it found that the fine was compensatory instead of punitive, the contempt order would have been an *interlocutory* order and the writ of mandamus would have been refused. This decision is, therefore, directly opposed to the practice

which the petitioner in the present cause is attempting to establish, permitting the use of the writ of mandamus to compel the reinstatement of a partial appeal which was dismissed as premature by an *interlocutory order* made during the progress of a cause of which the Court of Appeals has assumed jurisdiction.

The above review of the authorities submitted by the petitioner in support of its position shows conclusively that in *not one* was the writ of mandamus issued to aid an appeal from an *interlocutory order*, but that in *every case* the order, judgment or decree from which an appeal was sought, and in aid of which appeal the writ of mandamus was issued, was of such *final and conclusive character* that the refusal or dismissal of the appeal effectually ended the litigation, as a whole, or as to the particular litigant in question.

In the present cause, the order is purely interlocutory in character, dismissing an appeal from *a part only* of the subject-matter in litigation, while entertaining an appeal as to the remainder of the subject-matter, and merely requiring the petitioner to wait until a later stage in the litigation and until after the entry of a final decree before prosecuting an appeal as to the particular subject-matter in question.

In view of the above, it is respectfully submitted that the writ of mandamus should not issue in the present case:

(1) Because the petitioner has another adequate remedy and the issuance of the writ of mandamus is not essential in order that the litigation may proceed to a full determination.

(2) Because this is a patent cause of which this court does not have appellate jurisdiction and, accordingly, is without authority to issue the writ of mandamus in aid of the proceedings therein; and

(3) Because the order dismissing complainant's cross-appeal is a purely interlocutory order made in the progress of the litigation and is not of such final and conclusive character as to warrant the issuance of the writ of mandamus.

II.
As to The Merits.

But even though the issuance of the writ of mandamus were proper to correct an error in the dismissal of an appeal like that before the court, it is submitted that the dismissal was proper under the law and the authorities and that the writ of mandamus should be denied for this reason.

Three theories as to the nature of the two decrees have been presented by the opposing parties.

(1) It is the position of The Cutler-Hammer Mfg. Co., defendant, that the decrees of April 20th, 1905, and May 26, 1905, are both interlocutory decrees.

(2) It was the main contention of the petitioner at the argument of the motion to dismiss the cross-appeal that the first decree was interlocutory, while the second decree was final.

(3) It appears to be the main contention of the petitioner herein that both decrees are interlocutory but constitute, in effect, a single decree.

It is submitted that the first of the above theories is the only one which is tenable, but that under any aspect of the matter, the dismissal of complainant's appeal was proper in view of the law and authorities.

A.

We submit the following controlling propositions, which are established by the authorities and the record in this case.

(1) **The first decree entered April 20th, 1905, is interlocutory.** This fact is not disputed. The decree

> "Adjudged, ordered and decreed . . . that the said letters patent No. 499,769, granted June 20, 1893, to George Herbet Whittingham, as to claims 4, 5, 6, 7 and 8 thereof, are good and valid in law and that the defendant . . . has infringed upon claims 4 and 5 of said letters patent."

The decree granted an injunction and an accounting as to claims 4 and 5.

This decree granting a perpetual injunction but reserving an accounting is interlocutory and not final.

Smith v. *Vulcan Iron Works,* 165 U. S., 518, 524.
Keystone Co. v. *Martin,* 132 U. S., 91.
Crawford v. *Points,* 13 How., 11.
Barnard v. *Gibson,* 7 How., 650.
Humiston v. *Stainthorpe,* 2 Wall., 106.

(2) **The second decree entered May 24th, 1905, is interlocutory and not final.** This decree

> "Adjudged, ordered and decreed that the bill of complaint herein be, and the same hereby is dismissed as to claims 6, 7 and 8 of the Whittingham patent here in suit, as not being infringed by defendant."

This decree still left before the Circuit Court the accounting on claims 4 and 5, the control of the injunction which, upon motion, had been suspended by the Circuit Court, and the carrying out of the mandate of the Court of Appeals after its decision of the appeal from the first interlocutory decree, which appeal, on May 24th, 1905, had already been perfected and was pending before the Court of Appeals.

A decree which does not finally dispose of all the subject-matter in litigation is not a final decree, from which an appeal can be taken.

Keystone Co. v. *Martin,* 132 U. S., 91.
Crawford v. *Points,* 13 How., 11.
Barnard v. *Gibson,* 7 How., 650.
Humiston v. *Stainthorpe,* 2 Wall., 106.
Smith v. *Vulcan Works,* 165 U. S., 518.
Marden v. *Campbell,* 67 Fed. Rep., 811.

In **Keystone Co. v. Martin,** *supra,* this court said (p. 93):

> "We think that the decree is not a final decree, and that this court has no jurisdiction of the appeal. The decree is not final, because it does not dispose of the entire controversy between the parties. The bill prays only for an injunction and an account of the quantity and value of the ore taken from the land by the defendant. The injunction is granted, but the account remains to be taken. The case is not one where nothing remains to be done by the Court below, except to execute ministerially

its decree. In all cases like the one before us this Court has uniformly held that the decree was not final and was not appealable."

The court then discusses a number of authorities, among them:

Barnard v. Gibson, *supra.*

"In *Barnard* v. *Gibson,* the suit was one for the infringement of letters patent. By the decree of the Circuit Court a perpetual injunction was awarded, and it was referred to a master to ascertain and report the damages which the plaintiff had sustained. It was held that the decree was not appealable. The decree in that case was in all substantial particulars like the decree in the present case."

In **Humiston v. Stainthorpe,** *supra,* it was held that a decree in chancery awarding to a patentee a permanent injunction and an accounting of gains and profits is not a final decree from which an appeal can be taken.

In **Crawford v. Points,** *supra,* it was held that a decree which settled certain rights to property, but reserved an accounting of rents and profits was not a final decree from which an appeal would lie.

In **Smith v. Vulcan Works,** *supra,* it was held that a decree in a patent cause granting an injunction and referring the cause to a master for an accounting, was interlocutory and not final, and therefore not receivable on appeal before the final decree in the cause.

The above authorities clearly establish the principle that a decree such as the second decree entered in the present case under date of May 24th, 1905, is not a final decree because it does not finally dispose of all the subject-matter in litigation.

Petitioner's Authorities.—The petitioner, however, relies upon several authorities in support of its position that the second decree was final, and we shall now briefly analyze these authorities to show that neither supports the petitioner's contention.

Forgay v. Conrad, 5 How., 201, relied upon by the petitioner, was an exceptional case. The decree directed the defendant to pay a certain sum of money to the complainant, and the complainant

was entitled to have such decree *carried immediately into execution,* and under these exceptional circumstances the court held that an appeal would lie as from a final decree, notwithstanding there was an item of account to be adjusted. This case is analyzed and distinguished in **Keystone Iron Co. v. Martin,** 132 U. S., 91, 97, and its limited application pointed out; it is clear that the exceptional circumstances of that case are not present in the case now before this court.

The peculiar and exceptional character of the circumstances in *Forgay* v. *Conrad* is likewise discussed by this court in **Barnard v. Gibson,** 7 How., 650, 657, and this court said:

> "The decree in that case would have been executed by a sale of the property and the proceeds distributed among the creditors of the bankrupt and lost to the appellants, before the minor matters of account referred to the master could be adjusted and acted on by the court. The course of procedure in the Circuit Court was irregular, and the consequent injury to the defendants would have been irreparable."

This court thus makes it clear that *Forgay* v. *Conrad* was not intended as a departure in any manner from the uniform course of decisions of this court, holding that an appeal may be prosecuted only from a final decree, which puts an end to all of the subject-matter in litigation.

Hill v. Chicago Railroad Co., 140 U. S. 52, is another case referred to by the petitioner in support of its contention that the second decree is final. This case was also exceptional and does not alter the general law to the effect that the decree from which an appeal can be taken must be a final decree. In this case a final decree was entered disposing of every ground of contention between the parties, but referring to a master the ascertainment of the amount of one item which was separable from the other matters in controversy, and which concerned only a part of the defendants. This decree was held to be a final decree.

This court, in **Hohorst v. Hamburg-American Packet Co.,** 148 U. S., 262, 266, held that a decree dismissing the bill of complaint as to one of the several defendants was not a final decree as

to such defendant, which would sustain an appeal; and in that decision this court considered *Hill* v. *Chicago Railroad Co.*, and distinguished therefrom as follows:

> "There are cases in equity in which a decree disposing of every ground of contention between the parties, except as to the ascertainment of an amount in a matter separable from the other subjects of controversy, and relating only to some of the defendants, may be treated as final, though retained for the determination of such severable matter. *Hill* v. *Chicago & Evanston R. R.*, 140 U. S., 52. But this case presents no such aspect. Complainant insisted by his amended bill that the alleged liability was *joint*, and that 'all the defendants have co-operated and participated in all the said acts and infringement'."

Likewise, in the present case there is no severability between the subject-matter of claims 4 and 5 of the patent upon which an injunction was granted and the subject-matter of claims 6, 7 and 8, upon which the injunction was refused. These are all claims of a single patent, and the one device made by defendant was alleged in the bill of complaint to infringe all of the claims. The infringement alleged was joint. Accordingly, the feature of severability being absent, *Hill* v. *Chicago R. R. Co.* is not an authority for the petitioner's position.

This court, **in re Hohorst,** 150 U. S., 653, 657, again held that a decree not disposing of the litigation as to *all* the defendants, was not a final decree from which an appeal would lie.

Scriven v. North, 134 Fed. Rep., 366, is likewise not an authority for the petitioner's position. The bill of complaint in this case consolidated in one suit four separate and distinct causes of action: (1) patent infringement; (2) trade-mark infringement; (3) unfair copying of goods; and (4) unfair dressing of goods.

Courts of equity have uniformly permitted the joining of several distinct causes of action in one bill of complaint where the same act by defendant gives rise to the several causes of action, and where there is no diversity of defendants with respect to the several causes of action. Accordingly, such causes of action are severable. The decree in this case entered after a hearing on full proofs related to these four separate causes of action. As to all but the latter, the

bill was dismissed. The appeal was not taken under Section 7, as from an interlocutory decree, but was taken under Section 6, as from a final decree; the appeal was entertained, the court holding that the situation was exceptional and within the ruling of *Forgay* v. *Conrad*. The decree was held to be final, however, solely because of the separability of the several causes of action, which separability is entirely absent in the case now before the court.

In view of the authorities above discussed, it is clear that the second decree in this case, entered on May 26th, 1905, is an interlocutory decree and not a final decree. It does not dispose of the entire subject-matter in litigation, nor is the subject-matter of which it disposes severable from the remainder of the litigation; nor did it dispose of all subject-matter then remaining before the Circuit Court, because that court retained the accounting, which was not stayed by the appeal, the control of the injunction which had been suspended, and the court was subject to the mandate of the Court of Appeals upon the decision of defendant's appeal from the first decree granting an injunction as to claims 4 and 5.

In **Marden v. Campbell,** 67 Fed. Rep., 811, the court clearly points out that there cannot be two final decrees in a patent cause.

> "The settled practice of the supreme court touching appeals and writs of error is such as to prevent the same case reaching it a multiplicity of times, so far as practicable to accomplish this; and, moreover, by the settled modes of proceedings in equity in a cause of this kind, although there may be an interlocutory finding declaring certain claims void and others valid, yet there is only one final decree. It would be contrary to all well-conceived notions to imagine two final decrees in a patent cause of this character. The proposition of the complainant below in this direction cannot be entertained."

(3) **Defendant appealed May 12th, 1905, under Sec. 7 of the Judiciary Act of 1891, before the second decree was entered.** Defendant's appeal was taken under the authority granted by said section 7, allowing an appeal from an interlocutory order or decree *granting* an injunction; the first decree granted an injunction as to claims 4 and 5, and this decree was therefore appealable without waiting for the entry of the final decree.

The subsequent entry of the second decree after defendant's appeal had been perfected, cannot, therefore, affect or enlarge the rights of appeal based upon the first decree.

(4) **Complainant appealed June 7th, 1905, from the second decree entered May 24th, 1905.** This was an *independent* appeal from a supposed final decree, and not a cross-appeal. It was taken under Section 6 of the Judiciary Act of 1891, granting appeals from *final* decrees.

That complainant's appeal was taken as an independent appeal clearly appears from complainant's brief before the Circuit Court of Appeals in opposition to the motion to dismiss, from which we quote as follows:

> "The litigation as to claims 6, 7 and 8 remaining thus undisposed of by any order or decree on May 26th, 1905, there was entered a final decree as to claims 6, 7 and 8. And *this* is the decree from which we appeal. We appeal from it as from a *final* decree, under the reasoning and authority of *Scriven* v. *North*, 134 F. R., 366, 368, and cases cited. *Forgay* v. *Conrad*, 47 U. S., 250; *Potter* v. *Beal*, 50 F. R., 860."

In view of this statement in complainant's brief, there can be no question but that the appeal of complainant, which has been referred to as a cross-appeal, was taken as an independent appeal from a decree, supposed to be a final decree, under Section 6 of the Judiciary Act.

(5) **Complainant's appeal cannot be sustained as an independent appeal from a final decree,** because the second decree was an interlocutory decree, since it did not dispose of the entire litigation. Not being a final decree an independent appeal therefrom, under Section 6 of the Judiciary Act, was not authorized.

(6) **Complainant's appeal cannot be sustained as an independent appeal from an interlocutory decree,** since the second decree of May 24th, 1905, appealed from, *refused* an injunction and is, therefore, not appealable under Section 7.

(7) **Complainant's appeal cannot be sustained as a cross-appeal from the first interlocutory decree dated April 20th, 1905,** from which decree defendant appealed, because that

decree is wholly *in favor of complainant* and is *not adverse in any particular*. Accordingly, complainant cannot prosecute a cross-appeal or assign cross-errors based upon the first interlocutory decree, because a party cannot appeal from a decree which is wholly in his favor.

(8) **Complainant's appeal cannot be sustained as a cross-appeal based on the subsequent decree of May 24th, 1905,** because that decree was entered *after* the appeal had been perfected by defendant from the first interlocutory decree. Manifestly, after defendant's appeal from the first interlocutory decree had been perfected, May 12th, 1905, the Circuit Court lost jurisdiction of that decree and no action which complainant could take in the Circuit Court by the entry of a decree after that date could enlarge the rights of appeal based upon the first decree. There was nothing adverse to complainant in the first decree, so that a cross-appeal could not be based on that decre alone, and clearly no decree or order that might *thereafter* be entered by the Circuit Court could give to complainant any rights of cross-appeal in the Court of Appeals not based upon the first decree.

(9) **The two decrees cannot for the purpose of appeal be considered as one decree,** because the Circuit Court had lost jurisdiction of the first decree by defendant's appeal *before* the second decree was entered. Defendant perfected its appeal from the first decree, May 12th, 1905, and it was *after* this date, and on May 24th, 1905, that the second decree was entered, from which complainant appealed on June 7th, 1905. At the date, therefore, when the second decree was entered, the Circuit Court had lost jurisdiction of the first decree. The second decree, therefore, cannot be considered in any sense an *amendment* of the first decree, because the Circuit Court had lost jurisdiction of the first decree, and nothing which it could do at that time could in any manner alter the rights of defendant in its appeal from the first decree then pending before the Court of Appeals. Complainant's principal contention before this court is that the two decrees may be considered as constituting one decree, granting an injunction as to certain claims and refusing the injunction as to other claims, and that complainant by virtue of

its appeal can have reviewed the propriety of the refusal of the injunction. The facts in the present case, however, are very different from what they would have been had a *single* decree granting the injunction as to some of the claims and refusing the injunction as to other claims been entered *before* defendant's appeal. In the present case defendant's appeal intervened between the first and the second decrees and irrevocably separates them into two distinct decrees, which must, so far as the rights of appeal are concerned, stand each on its own base.

(10) **At the date of complainant's appeal defendant had not taken up a complete record,** or, in fact, any record; after both appeals had been taken, a joint record was made up; therefore, at the date of complainant's appeal there was no complete record before the Court of Appeals upon which a cross-appeal could be based.

B.

In view of the above propositions, it is apparent that the first of the three theories as to the nature of the two decrees is the only one which is tenable.

(1) Both decrees are interlocutory; defendant could appeal from the first decree because *it granted an injunction;* complainant could not appeal from the second decree because *it refused an injunction.*

(2) Complainant's appeal was taken on the theory that the second decree was *final* and would support an *independent* appeal; as the second decree was in fact interlocutory, not disposing of the entire litigation, the appeal, on the theory that it was an independent appeal from a final decree under Section 6 of the Judiciary Act, was properly dismissed.

(3) The main contention of the petitioner before this court is that the two decrees constitute, in effect, one decree, and that the appeal of complainant may, therefore, properly be considered as a cross-appeal; but the second decree was entered *after* the appeal on the first decree and could not therefore alter or affect the rights of appeal based on the first decree. Any right to a cross-appeal must be

based upon the first decree, from which defendant's appeal was taken; this decree was not adverse to complainant in any particular and the cross-appeal, therefore, would not lie.

But even though the subject-matter of the two decrees were embraced in a *single* decree, the authorities relied upon do not support the petitioner's position.

Smith v. Vulcan Iron Works, 165 U. S., 518, upon which the petitioner principally relies, was a case in which the patent was sustained as to *all* the claims in suit, and an injunction granted thereon. Upon appeal from this decree as an interlocutory decree, under Sec. 7 of the Judiciary Act, the question arose as to whether the Court of Appeals was limited to a review of the propriety of granting the injunction, whether improvident or not, or whether the court could go into the merits and consider also the question of validity and infringement and dismiss the bill if it found want of merits. It was held that the Court of Appeals had this authority. That is, on an appeal from an interlocutory decree granting an injunction, the Court of Appeals may consider:

(1) The propriety of granting the injunction;

(2) The validity of the claims; and

(3) The question of infringement.

If, in the opinion of the Court of Appeals, validity or infringement is not established, the bill may be dismised for want of merits.

In the present case, the interlocutory decree of April 20, 1905, finds:

(1) Validity;

(2) Infringement; and

(3) Grants an injunction as to claims 4 and 5, and contains no adverse finding as to the remaining claims in suit.

Therefore, under the doctrine of *Smith* v. *Vulcan Works*, the Court of Appeals may, upon defendant's appeal from this interlocutory decree, consider the *whole* of this interlocutory decree and pass upon the validity and infringement of claims 4 and 5, as well as upon the propriety of granting the injunction.

But the petitioner contends that *Smith* v. *Vulcan Works* not only

authorizes the Court of Appeals to pass upon the validity and infringement of the claims *upon which an injunction is granted,* but also where the decree *refuses* an injunction as to other claims, to pass upon this question of *refusal* of injunction. This is an entirely different question from that presented in *Smith* v. *Vulcan Works.* Moreover, this is a question which does not arise on the facts in the case now before this court, because here there is not a *single* decree granting an injunction as to some claims and *refusing* an injunction as to other claims. On the contrary, the first decree from which defendant has appealed and which appeal is now pending before the Court of Appeals, does *not* refuse an injunction as to any of the claims. The refusal of the injunction is embraced in the *second* interlocutory decree, entered May 24th, 1905, *after* defendant had perfected its appeal from the first decree.

But even though there was a single decree in the present case, both granting and refusing an injunction, it is submitted that *Smith* v. *Vulcan Works* is not authority for the Court of Appeals to pass upon the *refusal* of the injunction upon an appeal by the complainant under Sec. 7 of the Judiciary Act. On the contrary, we submit that under such circumstances, which are purely hypothetical, since they do not exist in this case, an appeal by the complainant from the portion of such a decree refusing the injunction, is expressly precluded by the clear language of the act itself.

It is clear that *Smith* v. *Vulcan Iron Works,* relied upon by complainant, does not decide the precise point which the petitioner is now attempting to establish.

C.

The Circuit Courts of Appeal, however, of most of the circuits have clearly announced the doctrine that where under Section 7 an appeal is taken from an interlocutory decree which both grants and refuses an injunction, the Circuit Court of Appeals will limit its review to that portion of the decree which grants the injunction, and will refuse to entertain an appeal or a cross-appeal from that portion of the decree which *refuses* an injunction.

The leading cases in the several circuits establishing this doctrine are as follows:

Second Circuit.

Thomson-Houston Co. v. *Nassau Co.*, 112 Fed. Rep., 676.

Kilmer Mfg. Co. v. *Griswold*, 67 Fed. Rep., 1017.

Eagle Lock Co. v. *Corbin Cabinet Lock Co.*, 64 Fed. Rep., 789.

Westinghouse Co. v. *Christenson Co.*, 104 Fed. Rep., 622.

First Circuit.

Marden v. *Campbell Co.*, 67 Fed. Rep., 809.

National Co. v. *Automatic Co.*, 105 Fed. Rep., 670.

Sixth Circuit.

Western Electric Co. v. *Abbott*, 108 Fed. Rep., 953.

Seventh Circuit.

Columbia Wire Co. v. *Boyce*, 104 Fed. Rep., 172.

Ninth Circuit.

Frye & Bruhn v. *Carstens*, 130 Fed. Rep., 766.

Thomson-Houston Co. v. Nassau Co., *supra*, was decided Dec. 9th, 1901. In this case a *single* decree was entered after final hearing, finding infringement of five claims, non-infringement of five claims and invalidity of two claims. A perpetual injunction and an accounting were granted as to the five claims held infringed, and the bill was dismissed as to the remaining seven claims. Complainant's appeal from the refusal of the injunction as to the seven dismissed claims was dismissed on motion.

Kilmer v. Griswold, *supra*, was decided April 23rd, 1895, while the original Act of 1891 was in force. Two patents were in suit; one patent was held infringed, and an injunction and accounting awarded, while the bill was dismissed as to the other patent. A single interlocutory decree was entered, from which both parties appealed. The court said:

> "Inasmuch as the decree of the Circuit Court is not final, the only appeal which can be considered is from so much of such decree as grants an injunction."

Eagle Lock Co. v. Corbin Cabinet Lock Co., *supra*, was decided December 3, 1894. After final hearing, one of the claims in

suit was sustained and a perpetual injunction and an accounting awarded, and the bill was dismissed as to the remainder of the claims in suit. From that part of the interlocutory decree which related to the claims sustained, an appeal was taken by defendant. This court said (p. 790):

> "As infringement is practically admitted, the validity of this claim is the only question before this court. The correctness of the other conclusions of the Circuit Court has not been considered, as the decree was not a final one."

That is, the court refused to consider the correctness of that portion of the interlocutory decree which dismissed the bill as to certain of the claims. The court thus limited its review to the claims upon which the injunction was granted.

Westinghouse Co. v. Christenson Co., *supra,* decided Oct. 24, 1900, after the amendment of 1900, was a case in which an interlocutory order was entered denying a preliminary injunction, and the Court of Appeals held that no appeal would lie from an order refusing an injunction.

Marden Mfg. Co. v. Campbell Co., *supra,* decided May 4, 1895, under the original act of 1891, was a case in which a decree was entered granting an injunction as to certain claims and refusing an injunction as to other claims. Defendant moved to dismiss the cross-appeal by complainant. The court analyzed the statute and the reasons for its enactment, and held that the statute permitted a defendant to obtain a speedy appeal when under injunction, but did not warrant the court to review that portion of the decree which refused an injunction. It was contended:

> "that so much of the decree below as adjudged certain claims invalid or not infringed, was final and entitled the complainant to an appeal independently of the second section of the Act of Mar. 3, 1891."

This is precisely the contention which is made by the petitioner herein with respect to the second decree, which refused an injunction as to claims 6, 7 and 8.

The court said:

> "On the contrary, the practice has been so continuous for

so long a time the other way, and with such universal acquiescence, that this proposition so far as we know has never been made nor any necessity arisen for its adjudication. This long continued recognition of the rule ought to be of itself a sufficient answer to complainant's proposition."

National Co. v. Automatic Co., *supra,* was decided under the Act as amended in 1900. A perpetual injunction was granted after final hearing and complainant appealed from that part of the decree which refused an injunction. On the authority of *Westinghouse Co.* v. *Christenson Co., supra,* the court refused to entertain this appeal.

Western Electric Co. v. Abbott, *supra,* was decided after the amendment of 1900. The decree granted an injunction as to two of the claims and refused an injunction as to a third claim. In this case it was contended, as does the petitioner here, that as the decree finally disposed of the first claim of the patent, an appeal would lie independently of the statute. The court overruled this contention, saying, on page 957:

"But as that part of the decree did not finally dispose of the whole case, which was retained for the purpose of an accounting upon the claims held valid, the right to appeal from the dismissal of the bill as to the first claim would be suspended until the final decree, when that action and any other which might be prejudicial, could be brought up on one appeal. The other course would sanction the bringing up of a case 'piecemeal.' In thus holding we are in agreement with the opinion of the circuit court of appeals for the First circuit in *Marden* v. *Printing-Press Co.*, 15 C. C. A., 26, 33 U. S. App., 123, 67 Fed., 809."

Columbia Mfg. Co. v. Boyce, *supra,* holds that since the amendment of 1900 there can be no appeal from an interlocutory order refusing a preliminary injunction. This case deals with a preliminary injunction as distinguished from a perpetual injunction. It holds that the amendment of 1900 repealed the amendment of 1895.

Fry & Bruhn v. Carstens, *supra,* is likewise a case dealing with a preliminary injunction and the court held that no appeal lies from an interlocutory order refusing a preliminary injunction.

We thus see that the Circuit Courts of Appeal have been quite uniform in holding that where an interlocutory decree both grants and refuses an injunction, the review will be limited to that part which grants the injunction, and that neither an independent appeal nor a cross-appeal by complainant to review that part refusing the injunction will be entertained.

However, there is a recent decision by the Court of Appeals for the Seventh Circuit, which has interpreted *Smith* v. *Vulcan Works* as authorizing the consideration of the portion of the decree refusing the injunction under certain conditions, which conditions, however, do not exist in the cause at present before the court.

D.

Chicago Co. v. Miller Co., 133 Fed. Rep., 145, is the case in the Seventh Circuit. This case, however, differs from the present case in two vital particulars.

(1) In that case there was a *single* decree granting an injunction as to part of the claims and refusing an injunction as to the remainder; in this case there are *two* separate interlocutory decrees, the first granting an injunction and the second refusing an injunction; the second decree from which complainant appeals having been entered *after* defendant had perfected its appeal from the first decree which granted an injunction.

(2) In that case defendant, in perfecting its appeal from the single decree, brought up the *entire* record to the Court of Appeals, and *after* the entire record had been brought to the Court of Appeals, complainant took a cross-appeal; in the present case, but a part of the record would have been taken up by the defendant had the appeal by the complainant not been taken. The patent exhibits and the evidence relating to claims 6, 7 and 8, on which the injunction was refused by the second decree, were entirely different from those relating to claims 4 and 5, upon which an injunction was granted by the first decree, and would not have been included in the record had not complainant appealed and assisted in making up a *joint* record in accordance with the rules to cover both appeals.

As appears from paragraph (11), page 13 of the Return in this case, there is a rule of the Circuit Court that where an appeal is taken by both the complainant and the defendant, the parties may agree that one certification and one transcript of record may be made up, containing the papers and documents to be relied upon by both parties, the cost thereof to be borne equally by the parties in the first instance, and to be apportioned thereafter by the Circuit Court of Appeals. In accordance with this rule a joint record was made, as appears from paragraph (11), page 13 of the Return, which concludes as follows:

> "That a joint record in this cause was made up by the complainant and defendant after the two appeals had been allowed."

Complainant, therefore, in the present case could not prosecute a cross-appeal on the theory that the defendant had taken up the *entire* record, as was the case in *Chicago Co.* v. *Miller Co.*, because in the present case no record whatever had been taken to the Court of Appeals at the date complainant prosecuted its appeal, and, as a matter of fact, complainant's appeal was originally prosecuted on the theory that the second decree was final and would, therefore, support an independent appeal.

E.

But even though the facts in the present case were the same as those in *Chicago Co.* v. *Miller Co.*, it is submitted that that case is not based upon a proper interpretation of the law:

(1) Because *Chicago Co.* v. *Miller Co.* is contrary to the express language of the statute and the evident intent of Congress in enacting the same; and

(2) Because *Smith* v. *Vulcan Works* is not authority for the doctrine announced in *Chicago Co.* v. *Miller Co.*

(1)

Section 7 of the Judiciary Act of 1891, allowing appeals from interlocutory orders or decrees (Stat. 1889-91, Ch. 517, pa. 828), reads as follows:

> "Sec. 7. That where, upon a hearing in equity in a district

court, or in an existing circuit court, *an injunction shall be granted or continued by an interlocutory order or decree,* in a cause in which an appeal from a final decree may be taken under the provisions of this act to the Circuit Court of Appeals, *an appeal may be taken from such interlocutory order or decree granting or continuing such injunction* to the Circuit Court of Appeals: Provided, That the appeal must be taken within thirty days from the entry of such order or decree, and it shall take precedence in the appellate court; and the proceedings in other respects in the court below shall not be stayed unless otherwise ordered by that court during the pendency of such appeal."

It will be noted that this section as originally enacted in 1891 allows an appeal within thirty days from an interlocutory order or decree *granting* or *continuing* an injunction. It does not allow an appeal from an order or decree *refusing* an injunction.

While this law was in force a number of decisions, heretofore discussed, were rendered by the several Circuit Courts of Appeals, holding that, in an appeal from an interlocutory decree granting an injunction as to certain claims and refusing an injunction as to other claims, the review would be limited to that portion of the decree which *granted* the injunction and that neither an independent appeal nor a cross-appeal from that portion of the decree refusing the injunction would be considered.

With the practice thus established, Section 7 was, in 1895, amended by Chapter 96 of the Statutes of 1895, to enlarge the right of appeal. Section 7, as thus amended, reads as follows (Stat. 1893-95, page 666):

"That, where, upon a hearing in equity in a district court or a circuit court, *an injunction shall be granted, continued, refused, or dissolved by an interlocutory order or decree, or an application to dissolve an injunction shall be refused* in a case in which an appeal from a final decree may be taken under the provisions of this act to the Circuit Court of Appeals, *an appeal may be taken from such interlocutory order or decree, granting, continuing, refusing, dissolving or refusing to dissolve an injunction* to the Circuit Court of Appeals; provided, that the appeal must be taken within thirty days from the entry of such order or decree, and it shall take precedence in the appellate court; and the proceedings in other respects in the court below

shall not be stayed unless otherwise ordered by that court during the pendency of such appeal; and provided further, that the court below may, in its discretion, require as a condition of the appeal, an additional injunction bond."

Section 7, as thus amended in 1895, provided for an appeal from a decree *refusing* or *dissolving* an injunction. Accordingly, complainant could appeal from a decree which alone refused an injunction or could prosecute an independent appeal or a cross-appeal from that portion of a decree refusing an injunction where the decree both granted and refused an injunction. This amendment altered the practice established by the courts by the decisions heretofore discussed.

In 1900 Section 7 was again amended by Chapter 803 of the Statutes of 1900 (Stat. 1899-01, p. 600), to read as follows:

> "Sec. 7. That where, upon a hearing in equity, in a district court or in a circuit court, or by a judge thereof in vacation, *an injunction shall be granted or continued* or a receiver appointed, *by an interlocutory order or decree*, in a cause in which an appeal from a final decree may be taken under the provisions of this Act to the Circuit Court of Appeals, *an appeal may be taken from such interlocutory order or decree granting or continuing such injunction*, or appointing such receiver to the Circuit Court of Appeals: Provided, that the appeal must be taken within thirty days from the entry of such order or decree, and it shall take precedence in the Appellate Court; and the proceedings in other respects in the court below shall not be stayed, unless otherwise ordered by that court, or by the appellate court or a judge thereof, during the pendency of such appeal: Provided further, that the court below may in its discretion require as a condition of the appeal, an additional bond."

It will be noted that the amendment of 1900 makes Section 7, so far as injunctions are concerned, practically the same as in the original Act of 1891. The amendment of 1900 grants appeal from an interlocutory order or decree appointing a receiver, but this alteration does not concern the present inquiry. So far as the question of injunction is concerned, the amendment of 1900 took away the right to appeal from an interlocutory order or decree *refusing* or *dissolving* an injunction. Accordingly, after the amendment of

1900 the decisions of the courts interpreting Section 7 of the original Act of 1891, became again effective. An independent appeal from an interlocutory order or decree, which alone refuses an injunction, cannot be entertained, nor can an independent appeal or a cross-appeal be prosecuted from that portion of an interlocutory decree or order refusing an injunction where the decree both grants and refuses an injunction. The decisions of the Courts of Appeals after 1900 are, with the exception of *Chicago Co.* v. *Miller Co.*, in conformity with this view.

The history of Section 7 and the amendments thereto, thus clearly establishes the intent of Congress to deny the right of prosecuting an appeal from a decree, or that portion of a decree, refusing an injunction, until after the entry of the final decree. The only review which is permitted prior to the entry of the final decree is when an injunction is granted, in which case irreparable injury might follow if a review was not permitted until after the entry of the final decree. In the case of the refusal of an injunction, however, no summary action results, and accordingly, the right of review must await the entry of the final decree.

(2)

We have heretofore directed attention to the fact that *Smith* v. *Vulcan Works* does not decide the precise point here involved. In that case an interlocutory decree was entered, which sustained *all* of the claims in suit and granted an injunction with respect thereto, so that no part of the decree *refused an injunction*. The injunction thus covered the entire case.

This court held that upon an appeal from such a decree, which granted an injunction (but which *did not refuse* an injunction), the *whole* decree was before the appellate tribunal for review, and that tribunal could investigate not only the propriety of granting the injunction, but could also determine the merits of the controversy and pass upon the questions of patentability and infringement, and had the power to dismiss the bill of complaint for want of equity should it find against the complainant upon the merits.

Smith v. *Vulcan Works* therefore does not decide that where an interlocutory decree both grants and refuses an injunction and the defendant prosecutes an appeal from that part of the decree which grants the injunction, the complainant can prosecute a cross-appeal from *that part* which *refuses* an injunction. This is the proposition for which the petitioner herein contends.

Upon defendant's appeal from that part of an interlocutory decree, granting an injunction, *Smith* v. *Vulcan Works* is authority for the Court of Appeals to investigate, not only (1) the propriety of granting the injunction, but (2) the validity of the claims in suit, and (3) the question of infringement thereof. But *Smith* v. *Vulcan Works* is not direct authority for the contention that the Court of Appeals has the jurisdiction also to entertain a cross-appeal from that part of the interlocutory decree refusing an injunction as to a part of the claims in suit.

The only theory, therefore, upon which *Smith* v. *Vulcan Works* may be held to be applicable to the present controversy is that certain general language employed in that case is applicable to the circumstances of the present controversy. This language reads as follows (page 524):

> "The provision of section 7 of the act of 1891, that where 'upon a hearing in equity' in a Circuit Court 'an injunction shall be granted or continued by an interlocutory order or decree,' in a cause in which an appeal from a final decree might be taken to the Circuit Court of Appeals, 'an appeal may be taken from such interlocutory order or decree granting or continuing such injunction' to that court, authorizes, according to its grammatical construction and natural meaning, an appeal to be taken from the whole of such interlocutory order or decree, and not from that part of it only which grants or continues an injunction."

The decision thus states that an appeal may be taken

> "from the whole of such interlocutory order or decree, and not from that part of it only which grants or continues an injunction."

In the case then before the court, the decree dealt only with the grant of an injunction, and consequently the *whole* decree concerned itself

with the grant of an injunction, and did not in any part concern itself with the *refusal* of an injunction. One part of the decree dealt with the finding of validity of the claims in suit, another part with the finding of infringement of the claims in suit, and another part with the issuance of an injunction. The question presented was whether the appellate tribunal must confine itself to that part which dealt with the issuance of the injunction or could also consider those parts which dealt with the questions of validity and infringement and upon which ultimately the propriety of issuing the injunction must rest. By the language above quoted, the court held that the *whole* of the decree, that is, the decree in its three parts, could be reviewed by the appellate tribunal.

The petitioner herein would expand this language beyond the facts then before the court, and contends that this general language authorizes the appellate tribunal to step *beyond the subject-matter concerned with the injunction* and to review by complainant's cross-appeal, parts of an interlocutory decree *dealing with the refusal of an injunction,* where it appears that the same interlocutory decree deals with both the granting and the refusal of an injunction.

One of the leading cases in the Courts of Appeals before *Smith* v. *Vulcan Works* was decided by this court, was

Richmond v. Atwood, 52 Fed. Rep., 10, decided by the Circuit Court of Appeals for the First Circuit. In this case an interlocutory decree was entered finding validity and infringement of the patent in suit and granting an injunction. The question arose as to whether the appellate tribunal on an appeal under Section 7 of the Act of 1891, could consider the merits and pass upon the questions of validity and infringement, or was confined to the mere question of the propriety of granting the injunction, this being the precise question which was presented in *Smith* v. *Vulcan Works.* After exhaustively reviewing the authorities the law was announced in *Richmond* v. *Atwood,* that the appellate tribunal could pass upon the merits, and this doctrine was thereafter approved and established in *Smith* v. *Vulcan Works.*

In **Marden v. Campbell Co.,** 67 Fed., 809, an interlocutory decree was entered both granting and refusing an injunction The defendant prosecuted an appeal under Section 7 of the Act of 1891, from that part of the interlocutory decree granting the injunction, and complainant prosecuted a cross-appeal from that part of the interlocutory decree refusing the injunction. Upon motion of defendant to dismiss complainant's cross-appeal, the identical question was presented to the Circuit Court of Appeals of the First Circuit that is presented by the petitioner herein. In *Marden* v. *Campbell Co.,* the decision in *Richmond* v. *Atwood* was relied upon, just as the petitioner herein relies upon *Smith* v. *Vulcan Works.*

In *Richmond* v. *Atwood* the court used general language in dealing with the facts in that case, which was susceptible of a broader interpretation than was there evidently intended, just as is the case in the present instance, where the petitioner endeavors to rely upon general language used by this court in *Smith* v. *Vulcan Works.*

The Court of Appeals for the First Circuit, in *Marden* v. *Campbell Co.,* analyzes this previous decision in *Richmond* v. *Atwood,* and specifically directs attention to the fact that the two cases are radically different in that in *Richmond* v. *Atwood* the interlocutory decree by the granting of the injunction disposed of the entire controversy, while in *Marden* v. *Campbell Co.*, the granting of the injunction was but a *part* of the subject-matter covered by the interlocutory decree, which also *refused* an injunction. The court held that, in view of *Richmond* v. *Atwood,* the appellate tribunal could consider all of the subject-matter of the interlocutory decree dealing directly or indirectly with the injunction, and could therefore pass upon the merits as to validity and infringement, but that this did not authorize the appellate tribunal to *reach out for parts of the decree not covered by the injunction,* or to permit the complainant to bring up such matters by cross-appeal. The court in *Marden* v. *Campbell Co.* said, in referring to *Richmond* v. *Atwood* (page 814):

"It is apparent, however, from the closing sentences in *Rich-*

mond v. *Atwood*, that the rule is one of equitable convenience, to be applied when the *full* record is brought before us on account of an appeal against an injunction granted by an interlocutory decree after a full hearing. There is no indication in *Richmond* v. *Atwood* of any disposition *to go further than this*, or to permit *other parts of a decree* to be brought up by cross appeals, or appeals of the complainant below, for the purpose of being heard as on an appeal from a final decree." (Italics ours.)

The court thus clearly points out that the doctrine announced in *Richmond* v. *Atwood*, where the granting of the injunction covered the whole case, is not to be construed as authorizing the complainant to prosecute a cross-appeal or an appeal from *that part* of an interlocutory decree not dealing with an injunction.

The court then directs attention to the fact that in *Richmond* v. *Atwood* the injunction covers the entire case, and for that reason the disposal of the entire subject-matter by the appellate tribunal cannot be objectionable to the court or the parties. The court says (page 814):

> "Under the circumstances of *Richmond* v. *Atwood*, the injunction covers the entire case, and thus an appeal from the injunction brings up the whole decree, and necessarily the whole record, so that the court is required, for the mere purpose of adjudicating, touching the injunction, to examine on appeal the entire case; and so no detriment to the court or the parties can come by its thereupon disposing of the merits, and entering orders to the circuit court analogous to those entered upon an appeal from a final decree."

The court then points out that the passing upon the whole decree in a case where the injunction covers the entire case, is very different from reaching out for matters not covered by the injunction, in a case where the decree relates to other matters besides the grant of an injunction. The court says (page 814):

> "This, however, is a very different thing from reaching out for parts of the record, and of the decree below, not covered by the injunction order. While it should not be said that *Richmond* v. *Atwood*, and the rules determined by it, are limited to cases in the precise condition of *Richmond* v. *Atwood* itself,

yet it is entirely clear, for the reasons which we have stated, that it was not therein intended to embrace within the scope of the conclusions in that case the disposition, as on its merits, of the entirety of an interlocutory decree of the character of the one at bar, which the injunction touches *only in part.*"

As above noted, the petitioner herein would interpret the general language used by the court in *Smith* v. *Vulcan Works* to permit a cross-appeal from that part of the interlocutory decree refusing an injunction, just as the complainant in *Marden* v. *Campbell Co.* would have interpreted the general language employed by the court in *Richmond* v. *Atwood* in support of the same proposition, and just as in *Marden* v. *Campbell Co.*, the fallacy of such contention was clearly pointed out, so in the present case for the same reasons *Smith* v. *Vulcan Works* cannot, in view of the different circumstances there presented, be authority for the position of the petitioner herein.

This court cites *Morden* v. *Campbell Co.*, approvingly in *Smith* v. *Vulcan Works.*

The foregoing discussion assumes that the granting and the refusing of the injunction are embraced in a *single* decree, for unless they are so embraced, even the general language employed in *Smith* v. *Vulcan Works* is not applicable. We have heretofore directed attention to the fact that in the present case before this court, there is not a *single* decree, both granting and refusing an injunction, but that, on the contrary, there were *two* separate and distinct interlocutory decrees, one granting an injunction and containing no finding adverse to complainant, and the other refusing an injunction. Defendant perfected its appeal from the first decree before the second decree was entered and before complainant prosecuted its appeal from the second decree. Accordingly, complainant's appeal cannot be considered in any sense a cross-appeal, but must stand or fall as an independent appeal. And, inasmuch as an appeal from a decree refusing an injunction cannot be taken under Section 7, but must be taken under Section 6, of the Act of 1891, the appeal from the second decree cannot stand, unless

it appears that the second decree was a *final* decree. We have heretofore shown conclusively, as we believe, that the second decree was not a final decree, because it did not dispose of the entire subject-matter in litigation.

It is respectfully submitted, in view of the above, that the petition for the writ of mandamus should be denied and the rule discharged,

(1) For the reason that the issuance of the writ of mandamus is not the proper practice under the circumstances of this case,

(*a*) because the petitioner has an adequate remedy by an appeal after the entry of a final decree,

(*b*) because the Supreme Court of the United States does not have appellate jurisdiction of this cause and cannot therefore grant the writ of mandamus in aid of these proceedings, and

(*c*) because the order of the Court of Appeals dismissing complainant's so-called cross-appeal was an interlocutory order entered in the progress of a cause of which the Court of Appeals has accepted jurisdiction and was not of that final and conclusive character which put the entire subject-matter in litigation out of court; and

(2) For the reason that the Circuit Court of Appeals was without jurisdiction to entertain complainant's appeal, or so-called cross-appeal,

(*a*) because the second interlocutory decree from which complainant appealed was not a final decree, and therefore an appeal does not lie under Section 6 of the Act of 1891,

(*b*) because the first interlocutory decree from which defendant appealed was wholly in favor of complainant and complainant could not therefore prosecute a cross-appeal therefrom under Section 7 of the Act of 1891,

(*c*) because the second interlocutory decree from which complainant appealed was entered after defendant had perfected its appeal from the first interlocutory decree and therefore complainant cannot base a cross-appeal upon the second interlocutory decree, and

(*d*) because even though the two decrees should be considered in effect a single decree (which they cannot under the circum-

stances), Section 7 of the Act of 1891 does not authorize an appeal from that portion of an interlocutory decree refusing an injunction.

Respectfully submitted,

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